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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,659	02/15/2002	Nicolai Bohm	tesa AG 1518-WCG	2959
27386	7590	01/27/2004		
WILLIAM GERSTENZANG NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017				
			EXAMINER WATKINS III, WILLIAM P	
			ART UNIT 1772	PAPER NUMBER

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,659

Applicant(s)

BOHM ET AL.

Examiner

William P. Watkins III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. The objection regarding claim 19 is withdrawn in view of applicant's amendment.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (EP 0959119 A) in view of Gobran (U.S. 5,547,766) further in view of Kollaja et al. (U.S. 6,436,531).

Inoue teaches a masking tape for an automotive application process that has a nonwoven top layer on a polymer substrate with a PSA bottom coating (abstract). Gobran teaches a pressure sensitive tape with a film substrate and a teaching that knit, woven and nonwoven layers can be used on the top of the polymer substrate. Kollaja et al. teaches the use of a plastic backing for a tape that is designed to be flexible in order to conform

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to an automobile body for masking purposes (abstract). The backing is made from a polymer blend that may comprise polypropylene, polyethylene or copolymers of alpha olefins, depending on the maximum temperature exposure of the tape (col. 5, lines 25-60). The polymers are blended to obtain an optimum Young's modulus of 103 MPa (N/sq mm) to 207 MPa, in order to have the desired flexibility to conform to automobile surfaces (col. 3, lines 25-30). The instant invention claims a knit layer on a polymer substrate with a bottom layer of PSA, and a method of using said tape with the polymer substrate having a Young's modulus of less than 300 N/sq mm (MPa). It would have been obvious to one of ordinary skill in to substitute a knit or woven layer for the nonwoven layer of Inoue because of teaching of Gobran that these are equivalent reinforcing layers in adhesive tapes. It further would have been obvious to have selected a polymer system, for the film backing of Inoue in view of Gobran, with an elastic modulus of 103 MPa to 207 MPa in order to have a good flexibility to conform to automobile surfaces because of the teachings of Kollaja et al. Use of the tape of Inoue as modified above in the known masking process of Inoue would also have been obvious given the motivation to make a different substrate structure by Gobran and Kollaja et al.

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Selection of specific film thickness and coating densities is taken as being within the ordinary skill depending on the specific final application.

4. Applicant's arguments filed 06 November 2003 have been fully considered but they are not persuasive.

Applicant argues that one of ordinary skill in the art would have known that the knit layer of Gobran would not have the same flexibility as the nonwoven layer of Gobran in the tape of Inoue et al. because Inoue et al. calls for high flexibility and stretch tolerance. The examiner disagrees because one of ordinary skill in the fabric art would know that a knit would have at least if not more flexibility and tolerance of being stretched than a nonwoven and thus not be taught away from as a substitute for the nonwoven of Inoue et al. The Young's modulus argument is addressed in the new rejection given above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



**WILLIAM P. WATKINS III
PRIMARY EXAMINER**

WW/ww

January 20, 2004